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Docket No. ODS/025

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Masood Garahi et al.

Application No.: 09/825,537 Confirmation No. 9788

Filed : April 2, 2001

For : SYSTEMS AND METHODS FOR PLACING  
PARIMUTUEL WAGERS ON FUTURE EVENTS

Group Art Unit : 2164

Examiner :

New York, NY 10020  
August 15, 2002

Hon. Commissioner for Patents  
P.O. Box 2327  
Arlington, Virginia 22202

Attention: Security Group  
Licensing Review

REQUEST FOR RECONSIDERATION OF PETITION  
FOR RETROACTIVE LICENSE UNDER 35 U.S.C. § 184

This is in response to a March 26, 2002 Decision on  
Request for Retroactive License Under 37 C.F.R. § 5.25  
("Decision") in the above-identified patent application.

The Decision relates to applicants' Petition for  
Retroactive License Under 35 U.S.C. § 184 and 37 C.F.R.  
§§ 5.14(a) and 5.25 ("Petition"), filed June 8, 2001. The  
Decision states that the Petition was denied because the  
individual who had the authority and filed the application in  
Malaysia has not declared that the application was filed through

error and without deceptive intent. The Decision further states that an explanation is needed on why the telephone call (original Petition page 2, ¶ 3) was not heeded.

Accordingly, applicants are submitting herewith:

1. Declaration of Dave A. Wyatt, the individual who had the authority and filed the application in Malaysia.

2. Declaration of Andrew W. Shiue, the individual who placed the telephone call discussed in the original Petition at page 2, ¶ 3.

3. Declaration of Joey Bennett, the individual who filed the April 4, 2001 facsimile letter from Martin Round discussed in the Declaration of Andrew W. Shiue at ¶ 5.

The Declarations set forth the proof that the application was filed through error and without deceptive intent. The Declarations further set forth an explanation as to why the telephone call (original Petition page 2, ¶ 3) was not heeded.

On April 2, 2001, a facsimile letter was sent from David Toma to Henry Goh & Co. to file a counterpart application (hereinafter "ODS/25 Malaysia") to the above-identified patent application in Malaysia by April 5, 2001. The facsimile letter enclosed a copy of the above-identified patent application.

Dave Wyatt of Henry Goh & Co. received the facsimile letter and the enclosed patent application from David Toma, which instructed Henry Goh & Co. to file ODS/25 Malaysia by April 5, 2001. These instructions were properly docketed by Henry Goh & Co.

On April 3, 2001 at 10:37 pm, Andrew W. Shiue contacted Henry Goh & Co. via telephone to further instruct them not to file ODS/25 Malaysia until April 5, 2001 because we were waiting for a foreign filing license to be granted.\* A foreign filing license was granted on April 5, 2001.

Dave Wyatt did not receive the April 3, 2001 telephone call that was placed by Andrew W. Shiue. The time of that call in Malaysia was 10:37 A.M. on April 4, 2001.

Dave Wyatt, on the morning of April 4, 2001, in accordance with the April 2, 2001 facsimile letter, filed ODS/25 Malaysia in the Malaysian Patent Office.

To the best of Dave Wyatt's understanding, the April 3, 2001 telephone call that was placed by Andrew W. Shiue was received by Martin Round of Henry Goh & Co. Martin Round worked in the trademark department at Henry Goh & Co.

To the best of Dave Wyatt's understanding, Martin Round believed that the April 3, 2001 telephone call that was placed by Andrew W. Shiue was regarding a trademark application, not a patent application.

A copy of an urgent facsimile of April 4, 2001 from Martin Round to Andrew W. Shiue is attached to Andrew W. Shiue's Declaration as Exhibit B. The heading of the urgent facsimile refers to "New Malaysia Trade Mark Applications in the name of ODS Properties" (emphasis added). The body of the facsimile of

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\* In the original Petition, it was mistakenly stated that the telephone call took place on April 2, 2001.

April 4, 2001 from Martin Round begins with "[f]urther to our conversation this morning." This confirms that Martin Round and Andrew W. Shiue had a telephone conversation on the morning of April 4, 2001 Malaysian time, which would be during the evening of April 3, 2001 in Eastern Daylight Time. This time corresponds to the time when Andrew W. Shiue placed the April 3, 2001 call to Henry Goh & Co.

The heading of the urgent facsimile copy attached to Andrew W. Shiue's Declaration as Exhibit B shows the words "Trade Mark" crossed out with the word "Patent" written in above "Trade Mark." Andrew W. Shiue did not notice that the heading stated "Trade Mark." Joey Bennett, the individual who filed the urgent facsimile crossed out "Trade Mark" and wrote in "Patent" because she understood that the facsimile letter was regarding a patent application, not a trade mark application; however, that correction was not made until some time after April 5, 2001

To the best of Dave Wyatt's understanding, he never received the telephone instructions to foreign file ODS/25 Malaysia on April 5, 2001 because Martin Round received the telephone instructions and believed them to refer to a trade mark application. Martin Round worked exclusively with regard to trade mark applications and Dave Wyatt works exclusively with regard to patent applications. To the best of Dave Wyatt's understanding, if Martin Round believed that the instructions were for a trade mark application, Martin Round would not have informed Dave Wyatt of them.

Applicants, therefore, did not have any intent to file ODS/25 Malaysia without a foreign filing license. Dave Wyatt of Henry Goh & Co. filed ODS/25 Malaysia on April 4, 2001 without deceptive intent because Dave Wyatt did not receive the instructions from Andrew W. Shiue to file ODS/25 Malaysia on April 5, 2001.

Accordingly, ODS/25 Malaysia was filed in Malaysia through error and without deceptive intent. In addition, the aforementioned facts explain why the April 3, 2001 telephone call from Andrew W. Shiue was not heeded.

Reconsideration of applicants' Petition in view of this evidence and the evidence presented in the originally-filed Petition papers is respectfully requested.

The Director is hereby authorized to charge any fee due in connection with this submission to Deposit Account No. 06-1075. A duplicate copy of this paper is enclosed.

Respectfully submitted,

James A. Leiz  
Reg. No. 46,109  
Agent for Applicants  
FISH & NEAVE  
Customer No. 1473  
1251 Avenue of the Americas  
New York, New York 10020  
Tel.: (212) 596-9000

## Enclosures

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Masood Garahi et al.

Application No.: 09/825,537 Confirmation No. 9788

Filed : April 2, 2001

For : SYSTEMS AND METHODS FOR PLACING PARIMUTUEL WAGERS ON FUTURE EVENTS

Group Art Unit : 2164

Examiner :

Hon. Commissioner for Patents  
P.O. Box 2327  
Arlington, Virginia 22202

Attention: Security Group  
Licensing Review

DECLARATION OF JOEY BENNETT IN SUPPORT OF PETITION  
FOR RETROACTIVE LICENSE UNDER 35 U.S.C. § 184

I, Joey Bennett, hereby declare as follows:

1. I am employed at Fish & Neave, 1251 Avenue of the Americas, New York NY, 10020 in the patent department.

2. At some time after April 4, 2001, I filed an April 4, 2001 facsimile letter from Martin Round in the patent files to which the letter referred. I noticed that the heading stated "New Malaysia Trade Mark Applications in the name of ODS Properties." I crossed out "Trade Mark" and wrote in "Patent" because I understood that the facsimile letter was regarding a patent application, not a trade mark application.

3. I hereby declare, further, that I understand the English language and that all statements made herein of my own knowledge are true and all statements made on information and belief are believed to be true; and further, that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the above-identified patent application or any patent issuing thereon.

Dated:

8/15/02

Joey Bennett  
Joey Bennett

122 / 130.00

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Docket No. ODS/025

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Masood Garahi et al.  
Application No.: 09/825,537 Confirmation No. 9788  
Filed : April 2, 2001  
For : SYSTEMS AND METHODS FOR PLACING PARIMUTUEL WAGERS ON FUTURE EVENTS  
Group Art Unit : 2164  
Examiner :

Hon. Commissioner for Patents  
P.O. Box 2327  
Arlington, Virginia 22202

Attention: Security Group  
Licensing Review

DECLARATION OF DAVE A. WYATT IN SUPPORT OF PETITION  
FOR RETROACTIVE LICENSE UNDER 35 U.S.C. § 184

I, Dave A. Wyatt, hereby declare as follows:

1. I am employed at Henry Goh & Co., Suite 3.02,  
Level 3, Amoda Building, 22, Jalan Imbi, 55100 Kuala Lumpur,  
Malaysia.

2. I received a facsimile letter of April 2, 2001  
from David Toma of Fish & Neave, which instructed Henry Goh &  
Co. to file a patent application (hereinafter "ODS/25 Malaysia")  
by April 5, 2001. ODS/25 Malaysia claims the benefit of the

above-identified patent application and U.S. provisional application No. 60/194,799, filed on April 5, 2000.

3. The April 2, 2001 facsimile instructions to file ODS/25 Malaysia by April 5, 2001 were properly docketed.

4. On the morning of April 4, 2001, in accordance with the April 2, 2001 facsimile instructions, I filed ODS/25 Malaysia in the Malaysian Patent Office.

5. I did not receive an April 3, 2001 telephone call that was placed by Andrew W. Shiue at 10:37 P.M. Eastern Daylight Time to Henry Goh & Co. The time of that call in Malaysia was 10:37 A.M. on April 4, 2001, the same morning during which I filed ODS/25 Malaysia.

6. To the best of my understanding, the April 3, 2001 telephone call that was placed by Andrew W. Shiue was received by Martin Round of Henry Goh & Co. Martin Round worked in the trademark department at Henry Goh & Co. To the best of my understanding, Martin Round believed that the April 3, 2001 telephone call that was placed by Andrew W. Shiue was regarding a trademark application, not a patent application. This is evidenced by our file copy of an urgent facsimile of April 4, 2001 from Martin Round to Andrew W. Shiue, which is attached hereto as Exhibit A. The heading of the facsimile of April 4, 2001 from Martin Round refers to "New Malaysia Trade Mark Applications in the name of ODS Properties" (emphasis added).

The facsimile of April 4, 2001 from Martin Round confirms that Martin Round and Andrew W. Shiue had a telephone conversation on the morning of April 4, 2001 Malaysian time, which would be during the evening of April 3, 2001 in Eastern Daylight Time. This time corresponds to the time when Andrew W. Shiue placed the April 3, 2001 call to Henry Goh & Co.

7. To the best of my understanding, I never received the telephone instructions to foreign file ODS/25 Malaysia on April 5, 2001 because Martin Round received the telephone instructions and believed them to refer to a trade mark application. Martin Round worked exclusively with regard to trade mark applications and I work exclusively with regard to patent applications. To the best of my understanding, if Martin Round believed that the instructions were for a trade mark application, he would not have informed me of them. To the best of my understanding, if Martin Round believed that the instructions were for a patent application, he would have informed me of them or would have informed one of the senior professionals in Henry Goh & Co.'s patent department, who would then have informed me.

8. I hereby declare, further, that I understand the English language and that all statements made herein of my own knowledge are true and all statements made on information and belief are believed to be true; and further, that these

statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the above-identified patent application or any patent issuing thereon.

Dated: 5th August 2002 Dave A Wyatt  
Dave A. Wyatt

吳亨利有限公司  
(專利及商標專務所)



Mailing Address:  
G.P.O. Box 13563,  
50814 Kuala Lumpur, MALAYSIA  
E-mail : hgoh@po.jaring.my  
Home Page : <http://www.henrygoh.com>

# HENRY GOH

PATENT & TRADEMARK AGENTS  
Malaysia and Singapore

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Suite 8.02, Level 3, AMODA BUILDING,  
22, Jalan Imbi, 55100 Kuala Lumpur, MALAYSIA.  
Tel : 60-3-2439122 (Hunting)  
Fax (General) : 60-3-2423354  
Fax (Patent) : 60-3-2434082, 2434083  
Fax (Trademark) : 60-3-2423110

Your Ref: ODS 25/26/28/32/34/38

Our Ref: Misc /M/Y/MC

Date: 4 April 2001

Fish & Neave  
New York, U.S.A.

By Facsimile (1) (212) 596 9090

Attention: Andrew Shiu

Dear Andrew:

**SUPER URGENT !**

Re: New Malaysia Trade Mark Applications in the name of ODS Properties.

Further to our conversation this morning, I have been told that we have not received any facsimiles either today or earlier this week for ODS Properties. We are about 14 hours ahead of New York, so we will have to receive any information for these applications as soon as possible.

Yours faithfully,

Dr. Martin C. Round  
**HENRY GOH & CO. SDN. BHD.**

HENRY H. R. GOH B. & K.  
Dipl. Elect Eng. (IEST), ACE (UK)  
Registered Patent & Trademark Agent

MARY BYBLE LOUBS  
LL.B. (London), Q.C.  
Registered Patent & Trademark Agent  
Admitted to the Malaysian Bar

THAM SAU YIN  
S.A. (Edus) (Caterbury, N.Z.)  
Registered Trademark Agent

DAVE A. WYATT  
B.Sc. (Eng) M.I.E.E  
Chartered Patent Agent UK & European  
Patent Attorney  
Registered Patent & Trademark Agent

MARTIN C. ROUND  
B.A., LL.B. (Canterbury, N.Z.)  
M.A. (Hons.) (Auckland, N.Z.)  
M.Phil., Ph.D (Columbia, New York, U.S.A.)

UDMA A. M. CEKARAH  
LL.B. (Wolverhampton)  
MAIDU APPANAH  
B.Sc. (Hons.) (Chm.) (Malaya)  
Registered Patent Agent

MARY YAP YUNG YUNG  
B.Sc. (Chem.) (Singapore)

SINGAPORE OFFICE  
AMEEN KALANI  
Legal Officer  
LL.B. (Hons.) (I.I.U., Malaysia)

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Examiner :

Hon. Commissioner for Patents  
P.O. Box 2327  
Arlington, Virginia 22202

Attention: Security Group  
Licensing Review

DECLARATION OF ANDREW W. SHIUE IN SUPPORT OF PETITION  
FOR RETROACTIVE LICENSE UNDER 35 U.S.C. § 184

I, Andrew W. Shiue, hereby declare as follows:

1. I am employed at Fish & Neave, 1251 Avenue of the  
Americas, New York NY, 10020.

2. I was assigned to assist David Toma of Fish & Neave  
in preparing the above-identified patent application (hereinafter  
"ODS/25") for foreign filing in Malaysia.

3. I assisted David Toma in preparing a letter that  
was sent via facsimile on April 2, 2001 to Henry Goh & Co. (our  
foreign contact in Malaysia) along with a copy of ODS/25. The  
April 2, 2001 letter instructed Henry Goh & Co. to file an

application (hereinafter "ODS/25 Malaysia"), claiming the benefit of ODS/25 and U.S. provisional application No. 60/194,799, filed on April 5, 2000, by April 5, 2001.

4. On April 3, 2001 at 10:37 pm, I contacted Henry Goh & Co. via telephone to further instruct them not to file ODS/25 Malaysia until April 5, 2001 because we were waiting for a foreign filing license to be granted. A copy of Fish & Neave's telephone records is attached hereto as Exhibit A as evidence of the telephone instructions.

5. On April 4, 2001, I received a facsimile letter from Martin Round that confirms the April 3, 2001 telephone call. (The facsimile confirms a call on the morning of April 4, 2001 in Malaysia, which was the evening of April 3, 2001 in Eastern Daylight Time.) In addition, the facsimile letter states that they did not receive any facsimiles either on April 4, 2001 or earlier in the week for ODS Properties. A copy of the facsimile letter from Martin Round is attached hereto as Exhibit B. This statement, however, conflicts with a facsimile letter from Dave A. Wyatt that David Toma received on April 3, 2001. The facsimile letter from Dave A. Wyatt states that David Toma's letter sent via facsimile on April 2, 2001 was received along with the copy of ODS/25. The facsimile letter from Dave A. Wyatt further states that the ODS/25 Malaysia will be filed by the priority deadline of April 5, 2001. Therefore, I was confident that Henry Goh & Co. had received David Toma's facsimile letter

of April 2, 2001. A copy of the facsimile letter from Dave A. Wyatt is attached hereto as Exhibit C.

6. Between May 1, 2001 and June 8, 2001, I worked with David Toma in determining how ODS/25 Malaysia was filed a day earlier than instructed. During that time, I mistakenly believed that my telephone instructions to Henry Goh & Co., discussed supra at ¶ 4 and discussed in the June 8, 2001 Declaration of David Toma at ¶ 7, occurred on April 2, 2001. However, only upon recent review of Fish & Neave's telephone records did I realize that I in fact placed the call on April 3, 2001.

7. I hereby declare, further, that I understand the English language and that all statements made herein of my own knowledge are true and all statements made on information and belief are believed to be true; and further, that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the above-identified patent application or any patent issuing thereon.

Dated: August, 2002

Andrew W. Shiue  
Andrew W. Shiue

# Fish & Neave

## Telephone Last Exported

Detail Report  
Transactions Exported 4/9/01 11:13:29 pm

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22, Jalan 11/114, 55100 Kuala Lumpur, MALAYSIA.  
Tel : 60-3-2439122 (Hunting)  
Fax (General) : 60-3-2429354  
Fax (Patent) : 60-3-2434062, 2434083  
Fax (Trademark) : 60-3-2123110

Your Ref: ODS 23/26/28/32/34/38

Our Ref: Misc /M/Y/MC

Date: 4 April 2001

Fish & Neave  
New York, U.S.A.

By Facsimile (1) (212) 596 9090

Attention: Andrew Shiue

Dear Andrew:

**SUPER URGENT!**

*Patent*  
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Further to our conversation this morning, I have been told that we have not received any facsimiles either today or earlier this week for ODS Properties. We are about 14 hours ahead of New York, so we will have to receive any information for these applications as soon as possible.

Yours faithfully,

Dr. Martin C. Round  
HENRY GOH & CO. SDN. BHD.

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BY FAX/EMAIL  
2001 APR - 4 A 8:40  
FISH & NEAVE  
REFERRED TO  
NOTED BY  
*(initials)*

HENRY H. P. GOH & CO. LTD.  
Opt. Elec. Eng. (1971) A/S (UK)  
Registered Patent & Trademark Agent

MARY RYER & CO LTD  
LL.B. (London), CLP  
Registered Patent & Trademark Agent  
Authorised to the Malaysian Govt

THAM SAIU YIM & CO LTD  
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R.94 C550 M162  
Chartered Patent Agent UK & European  
Patent Attorney  
Registered Patent & Trademark Agent

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M.Phil., Ph.D (Columbia, New York, U.S.A.)  
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*Mr. Foster*  
**HENRY GOH & CO. SDN. BHD. (332744-A)**  
Suite 3.02, Level 3, AMODA BUILDING,  
22, Jalan Imbi, 55100 Kuala Lumpur, MALAYSIA.  
Tel : 60-3-2439122 (Hunting)  
Fax (General) : 60-3-2423354  
Fax (Patent) : 60-3-2434062, 2434063  
Fax (Trademark) : 60-3-2423110

Your Ref: ODS/025

Our Ref: P-12971/DW/ac

Date: 03-Apr-2001

**FISH & NEAVE**  
1251 Avenue of the Americas  
New York, NY 10020  
U.S.A.

**Attention: David Toma**

Fax: 212-596-9090

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**APR 16 2001**

**FISH & NEAVE - PATENT DEPT.**  
REFERRED TO JMG  
VOTED BY DT

Dear Sirs,

Re: Proposed New Patent Application in Malaysia  
"Systems and Methods for Placing Parimutuel Wagers on Future Events"  
ODS PROPERTIES, INC.  
**Deadline: 5th April 2001**

We refer to your order letter via facsimile dated 2<sup>nd</sup> April 2001 together with the patent documents consisting of the following: -

1)Invention description	[ 49 pages ]
2)Claims	[ 6 pages ]
3)Drawings	[ 16 pages ]
4)Abstract	[ 1 page ]

We are now in the process of preparing the formal filing documentation. Rest assured that the application will be filed by the priority deadline of **5th April 2001** claiming priority to the **U.S.A.** basic applications. Priority Documents are not required for filing in Malaysia.

Immediately upon filing the application, we shall report to you again. Thank you for entrusting the handling of this application to our office.

Yours sincerely,

**HENRY GOH & CO. SDN. BHD.**

*Dave A. Wyatt*  
DAVE A. WYATT

HENRY H. P. GOH 天祐生  
Dipl. Elec. Eng. (IST), ASE (UK)  
Registered Patent & Trademark Agent

MARY SYBLE LOUIS  
LL.B. (London), CLP  
Registered Patent & Trademark Agent  
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THAM SAU YIN 陳秀燕  
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DAVE A. WYATT  
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Registered Patent Agent

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B.Sc. (Chem.) (Singapore)

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Legal Officer  
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